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10/507,927	09/17/2004	Tomomi Tateishi	1330-0141PUS1	6806

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EXAMINER	
MCCLELLAND, KIMBERLY KEIL	
ART UNIT	PAPER NUMBER
1791	

NOTIFICATION DATE	DELIVERY MODE
09/08/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	10/507,927	TATEISHI, TOMOMI	
	Examiner	Art Unit	
	KIMBERLY K. MCCLELLAND	1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *6/26/06*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-14 and 16-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-14 and 16-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant is reminded they need to explicitly point out where support for all the newly claimed features comes from as required by MPEP 714.02 and 2163.06. See 37 CFR 1.111. Applicant has not provided proper support for all newly added limitations.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-2, 4, 7-14, and 17-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

4. As to claims 1, 13, 17, and 18, the limitations of "without decompressing a space between said transfer material and said substrate" and "entirely" transferring the thin film layer are new matter. Examiner notes the limitation of "entirely" transferring has been presented in a previous amendment dated 8/10/06. This previous amendment was also rejected as new matter in the nonfinal rejection dated 10/16/06 (See

paragraph 2). The specification and drawings of record do not support heating and pressing without decompressing or transferring the thin film entirely. There is no suggestion of transferring the thin-film layer entirely or without decompression in the current specification. There is no suggestion of transferring the entire thin-film layer in page 16, line 20 through page 17, line 7 or in Figure 1 as declared by applicant. To transfer the entire thin-film layer, the substrate must be at least the same dimensions of thin-film layer. Negative limitations recited to overcome prior art can be considered new matter. Furthermore, the mere absence of a positive recitation in the original specification is not basis for the exclusion of a feature. *Ex Parte Grasselli et al. 231 USPQ 393*. These new limitations constitute new matter. Claims 2, 7, 7-12, and 14 are rejected due to their dependency on independent claims 1, 13, and 17-18.

5. The proscription against the introduction of new matter in a patent application (35 U.S.C. 132 and 251) serves to prevent an applicant from adding information that goes beyond the subject matter originally filed. See In re Rasmussen, 650 F.2d 1212, 1214, 211 USPQ 323, 326 (CCPA 1981). See MPEP § 2163.06 through § 2163.07 for a more detailed discussion of the written description requirement and its relationship to new matter.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-2, 4-14, and 16-18 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,194,119 B1 to Wolk et al. in view of U.S. Patent Application Publication No. 2002/0127877 to Shibata et al.

8. With respect to Claim 1, Wolk et al. discloses a method for thermal transfer for forming organic electroluminescent devices. Wolk et al. discloses heating (column 4, lines 31-37) and pressing (column 7, lines 18-22) a transfer material having an organic thin-layer (column 2, lines 38-41) formed on a temporary support (column 1, line 66-column 2, line 5) and a first laminate comprising a substrate (column 19, lines 17-22) and at least a transparent conductive layer or a rear-surface electrode (column 19, lines 42-45) formed on said substrate, which overlap each other such that said organic thin-film layer of said transfer material faces only the side of said substrate having said transparent conductive layer formed thereon being intended to form a receiving surface (See Figure 5A), thereby forming a laminate structure; peeling said temporary support from said laminate structure to entirely transfer said organic thin-film layer to said receiving surface of said first laminate (column 12, lines 9-13); and bonding a second laminate (column 12, lines 45-56) comprising a substrate (copper phthalocyanine, column 23, lines 41-42) and at least a rear-surface electrode or a transparent conductive layer (aluminum cathode, column 23, lines 44-45) formed on said substrate to said organic thin-film layer transferred onto said first laminate, wherein the heating is carried out by an infrared heater (column 32, line 15-column 24, line 22, column 12, lines 9-13, column 8, lines 38-40 and column 4, lines 31-37). Wolk et al. discloses the

transfer can be done according to any pattern, which is controlled by the amount of light exposure on the transfer material (column 4, lines 40-45). Examiner notes that in the areas where the thin film is transferred, it is transferred entirely (See Figure 5A). Also, in the absence of a positive recitation of decompressing, it is inherent the heating and pressing is done without decompressing a space between said transfer material and said substrate. However, Wolk does not specifically disclose the application angle or the peeling angle of the thin film.

9. Shibata et al. discloses a method for thermal transfer for forming organic electroluminescent devices including adjusting the angle of said transfer material to said first laminate to 90° or less and a peeling angle of said temporary support from said organic thin-film laver to 90° or more (See Figures 1a and 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the application and peeling angles taught by Shibata et al. in the transfer method of Wolk et al. The motivation would have been to efficiently transfer the thin film at a reduced cost (see paragraph 0011).

10. As to Claim 2, Wolk et al. discloses transferring by heating and pressing (column 7, lines 18-22).

11. As to claim 4, Wolk et al. discloses the transfer material is formed by a wet method (coating; column 5, lines 48-50).

12. As to claim 5, Wolk et al. discloses the second laminate has an organic thin-film layer formed on the rear-surface electrode (column 23, lines 47-49).

13. As to claim 6, Wolk et al. discloses the first laminate and second laminate have a thermal expansion coefficient of 20ppm/°C or less (column 19, lines 17-29, column 15, lines 48-59, column 32, line 15-column 24, line 22).

14. As to claim 7, Wolk et al. discloses the organic thin-film layer contains at least a light-emitting, organic compound or a carrier-transporting, organic compound (column 2, lines 37-41).

15. As to claim 8, Wolk et al. discloses a hole-transporting, organic thin-film layer, a light-emitting, organic thin-film layer and an electron-transporting, organic thin-film layer are successively transferred (column 15, lines 11-16, and column 16).

16. As to claim 9, Wolk et al. discloses at least one of said first substrate and said second substrate is provided with a transparent conductive layer (column 15, lines 40-43).

17. As to claim 10, Wolk et al. discloses at least one of said temporary support and said substrate is in the form of a continuous web (column 7, lines 9-11).

18. As to claim 11, Wolk et al. discloses the substrate is made of at least one material selected from the group consisting of polyimides; polyesters; polycarbonates; polyether sulfone; metal foils such as aluminum foil, copper foil, stainless steel foil, gold foil, silver foil; plastic sheets of liquid crystal polymers; fluorine-containing polymers such as polytchloroziuoroethylene), polytetrafluoroethylene, polytetrafluoroethylene-polyethylene copolymers (column 19, lines 17-29).

19. As to claim 12, Wolk et al. discloses a device formed from claim 1 (column 15, line 55-column 16, line 22).

20. As to claim 13, Wolk et al. discloses a method for thermal transfer for forming organic electroluminescent devices. Wolk et al. discloses heating (column 4, lines 31-37) and pressing (column 7, lines 18-22) a transfer material having an organic thin-layer (column 2, lines 38-41) formed on a temporary support (column 1, line 66-column 2, line 5) and a first laminate comprising a substrate (column 19, lines 17-22) and at least a transparent conductive layer or a rear-surface electrode (column 19, lines 42-45) formed on said substrate, which overlap each other such that said organic thin-film layer of said transfer material faces only the side of said substrate having said transparent conductive layer formed thereon being intended to form a receiving surface (See Figure 5A), thereby forming a laminate structure; peeling said temporary support from said laminate structure to transfer said organic thin-film layer to said receiving surface of said first laminate (column 12, lines 9-13); and bonding a second laminate (column 12, lines 45-56) comprising a substrate (copper phthalocyanine, column 23, lines 41-42) and at least a rear-surface electrode or a transparent conductive layer (aluminum cathode, column 23, lines 44-45) formed on said substrate to said organic thin-film layer transferred onto said first laminate, wherein the heating is carried out by an infrared heater (column 32, line 15-column 24, line 22, column 12, lines 9-13, column 8, lines 38-40 and column 4, lines 31-37). Wolk et al. discloses the transfer can be done according to any pattern, which is controlled by the amount of light exposure on the transfer material (column 4, lines 40-45). Examiner notes that in the areas where the thin film is transferred, it is transferred entirely (See Figure 5A). Also, in the absence of a positive recitation of decompressing, it is inherent the heating and pressing is done

without decompressing a space between said transfer material and said substrate. However, Wolk does not specifically disclose the application angle or the peeling angle of the thin film.

21. Shibata et al. discloses a method for thermal transfer for forming organic electroluminescent devices including adjusting the angle of said transfer material to said first laminate to 90° or less and a peeling angle of said temporary support from said organic thin-film laver to 90° or more (See Figures 1a and 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the application and peeling angles taught by Shibata et al. in the transfer method of Wolk et al. The motivation would have been to efficiently transfer the thin film at a reduced cost (see paragraph 0011).

22. As to claim 14, Wolk et al. discloses transferring by heating and pressing (column 7, lines 18-22).

23. As to claim 16, Wolk et al. discloses the second laminate has an organic thin-film layer formed on the rear-surface electrode (column 23, lines 47-49).

24. As to claim 17, Wolk et al. discloses a method for thermal transfer for forming organic electroluminescent devices. Wolk et al. discloses heating (column 4, lines 31-37) and pressing (column 7, lines 18-22) a transfer material having an organic thin-layer (column 2, lines 38-41) formed on a temporary support (column 1, line 66-column 2, line 5) and a first laminate comprising a substrate (column 19, lines 17-22) and at least a transparent conductive layer or a rear-surface electrode (column 19, lines 42-45) formed on said substrate, which overlap each other such that said organic thin-film layer

of said transfer material faces only the side of said substrate having said transparent conductive layer formed thereon being intended to form a receiving surface (See Figure 5A), thereby forming a laminate structure; peeling said temporary support from said laminate structure to transfer said organic thin-film layer to said receiving surface of said first laminate (column 12, lines 9-13); and bonding a second laminate (column 12, lines 45-56) comprising a substrate (copper phthalocyanine, column 23, lines 41-42) and at least a rear-surface electrode or a transparent conductive layer (aluminum cathode, column 23, lines 44-45) formed on said substrate to said organic thin-film layer transferred onto said first laminate, wherein the heating is carried out by an infrared heater (column 32, line 15-column 24, line 22, column 12, lines 9-13, column 8, lines 38-40 and column 4, lines 31-37). Wolk et al. discloses the transfer can be done according to any pattern, which is controlled by the amount of light exposure on the transfer material (column 4, lines 40-45). Examiner notes that in the areas where the thin film is transferred, it is transferred entirely (See Figure 5A). Also, in the absence of a positive recitation of decompressing, it is inherent the heating and pressing is done without decompressing a space between said transfer material and said substrate. However, Wolk does not specifically disclose the application angle or the peeling angle of the thin film.

25. Shibata et al. discloses a method for thermal transfer for forming organic electroluminescent devices including adjusting the angle of said transfer material to said first laminate to 90° or less and a peeling angle of said temporary support from said organic thin-film laver to 90° or more (See Figures 1a and 2). It would have been

obvious to one of ordinary skill in the art at the time the invention was made to combine the application and peeling angles taught by Shibata et al. in the transfer method of Wolk et al. The motivation would have been to efficiently transfer the thin film at a reduced cost (see paragraph 0011).

26. As to claim 18, Wolk e al. discloses a method for thermal transfer for forming organic electroluminescent devices. Wolk et al. discloses heating (column 4, lines 31-37) and pressing (column 7, lines 18-22) a transfer material having an organic thin-layer (column 2, lines 38-41) formed on a temporary support (column 1, line 66-column 2, line 5) and a first laminate comprising a substrate (column 19, lines 17-22) and at least a transparent conductive layer or a rear-surface electrode (column 19, lines 42-45) formed on said substrate, which overlap each other such that said organic thin-film layer of said transfer material faces only the side of said substrate having said transparent conductive layer formed thereon being intended to form a receiving surface (See Figure 5A), thereby forming a laminate structure; peeling said temporary support from said laminate structure to transfer said organic thin-film layer to said receiving surface of said first laminate (column 12, lines 9-13); and bonding a second laminate (column 12, lines 45-56) comprising a substrate (copper phthalocyanine, column 23, lines 41-42) and at least a rear-surface electrode or a transparent conductive layer (aluminum cathode, column 23, lines 44-45) formed on said substrate to said organic thin-film layer transferred onto said first laminate, wherein the heating is carried out by an infrared heater (column 32, line 15-column 24, line 22, column 12, lines 9-13, column 8, lines 38-40 and column 4, lines 31-37). Wolk et al. discloses the transfer can be done

according to any pattern, which is controlled by the amount of light exposure on the transfer material (column 4, lines 40-45). Examiner notes that in the areas where the thin film is transferred, it is transferred entirely (See Figure 5A). Also, in the absence of a positive recitation of decompressing, it is inherent the heating and pressing is done without decompressing a space between said transfer material and said substrate. However, Wolk does not specifically disclose the application angle or the peeling angle of the thin film.

27. Shibata et al. discloses a method for thermal transfer for forming organic electroluminescent devices including adjusting the angle of said transfer material to said first laminate to 90° or less and a peeling angle of said temporary support from said organic thin-film laver to 90° or more (See Figures 1a and 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the application and peeling angles taught by Shibata et al. in the transfer method of Wolk et al. The motivation would have been to efficiently transfer the thin film at a reduced cost (see paragraph 0011).

Response to Arguments

28. Applicant is reminded they need to explicitly point out where support for all the newly claimed features comes from as required by MPEP 714.02 and 2163.06. See 37 CFR 1.111. Applicant has not provided proper support for all newly added limitations.

29. Applicant's arguments filed 6/26/08 have been fully considered but they are not persuasive.

30. Applicant's arguments with respect to claims 1-2, 4-14 and 16-18 are have been considered but are moot in view of the new ground(s) of rejection. Applicant's remaining arguments are addressed below:

31. Applicant primarily argues limitations that are found to be new matter.

32. The limitations of heating and pressing without decompressing and entirely transferring the thin film layer are found to be new matter.

33. The proscription against the introduction of new matter in a patent application (35 U.S.C. 132 and 251) serves to prevent an applicant from adding information that goes beyond the subject matter originally filed. See In re Rasmussen, 650 F.2d 1212, 1214, 211 USPQ 323, 326 (CCPA 1981). See MPEP § 2163.06 through § 2163.07 for a more detailed discussion of the written description requirement and its relationship to new matter.

34. As to applicant's argument against Shibata, Shibata clearly teaches pressing where a peeling transfer process with heating to soften the organic thin film (See paragraph 0062; "Heating may be achieved by means of a laminator"). Examiner notes once the new matter is removed from the claims, Shibata again anticipates the current invention under 35 U.S.C. 102 (e).

35. With respect to applicant's arguments that Wolk does not disclose a peeling step, applicant is directed to column 12, lines 9-13, which discloses transferring the thin film layer with or without a release layer. This meets applicant's claimed peeling step. Also,

the portions of the thin film that are transferred are transferred entirely (Figures 5A-5B), and consequently, meet applicant's claimed transferring the entire thin film layer. Examiner notes this limitation is also new matter, and was previously rejected as being new matter in paragraph 2 of the office action dated 10/16/06. Please review MPEP § 2163.06 through § 2163.07 for a more detailed discussion of the written description requirement and its relationship to new matter.

36. Consequently, the applicant's arguments are not persuasive.

Conclusion

37. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to whose telephone number is (571)272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Thr.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571)272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. K. M./
Examiner, Art Unit 1791

KKM

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791